

**REMARKS**

In the Official Action, the Examiner maintained the rejection of all the claims under consideration based on the combination of Pettigrew et al., U.S. Patent No. 4,960,651, in view of Jin et al., U.S. Patent No. 7,106,163.

By the present Amendment, claim 1 has been amended to recite that the laminate comprising two or more magnetic metal thin plates has each magnetic metal thin plate "being selected from the group consisting of an amorphous metal plate, a nano crystal magnetic plate and a silicon steel sheet." This recitation is supported by the specification, such as in paragraphs [0016] to [0018] and original claim 4 which has now been canceled without prejudice or disclaimer. Thus, the amendment to claim 1 is proper in all respects. It will be recognized that the claimed materials are reflected in the illustrative examples provided in the specification and help enable the advantageous results shown in Table 1 on page 22.

The cited prior art does not disclose or suggest the subject matter now defined in the claims of record. As explained in the remarks of the previous response, Pettigrew et al. relates to an anti-pilferage magnetic device comprising a substrate and a thin coating of a magnetic material. An illustrative arrangement is shown in Figure 2 with components 1 and 8 being face and backing sheets, respectively, components 2, 5 and 7 being adhesive layers, component 3 being an amorphous metal glass and component 6 being a deactivating element.

Based on the discussion in columns 7 and 8 (e.g., see column 8, lines 27-29), the deactivating element must be magnetically semi-hard. The deactivation regimes are set forth in the passage beginning at column 7, line 61 and include a mild steel foil, cold worked stainless steel foil or strips, steel fibers, a thick film ferrite, zones of

a hard magnetic material and the aforementioned discrete islands or strips of the deactivating material. A thin foil of stainless steel is used in Example 1 of the patent.

Pettigrew et al. does not meet the recitation in claim 1 of a laminate comprising two or more magnetic metal thin plates has each magnetic metal thin plate "being selected from the group consisting of an amorphous metal plate, a nano crystal magnetic plate and a silicon steel sheet." If the deactivating element 6 was made of a soft magnetic material, such as an amorphous metal plate, the resulting device would not be able to function as an antipilferage tag which is the stated function of the device of the patent. It is further noted that the stainless steel foil used in Example 1 and described in the passage starting at column 8, line 43 is not a silicon steel which typically contains 3-8% of silicon. Moreover, if a silicon steel sheet was used in place of the stainless steel foil in the device of Pettigrew et al., there is the possibility that the layer would not be capable of being deactivated since the silicon steel would function as an active layer. Accordingly, since it would not proper to modify the prior art if the effect would be to defeat the purpose of the disclosed subject matter, it is apparent that Pettigrew et al. cannot be used as a basis for rejecting any of the claims of record.

Jin et al. has been relied on for a teaching of a high molecular compound. Although applicants have previously explained why those of ordinary skill in the art would not modify the magnetic device of Pettigrew et al. based on the teachings of Jin et al. in the manner proposed by the Examiner, even if the hypothetical combination was premised on a proper basis, it still would not overcome the deficiencies of Pettigrew et al. and would not result in the invention as defined in the claims of record. In this regard, it is again noted that Pettigrew et al. provides a magnetic device that is used as an antipilferage tag or marker where as Jin et al.


relates to an isolation transformer core having a coil and a core member; two distinct areas of endeavor. Accordingly, the present claimed invention is patentable in all respects over the cited prior art.

In view of the foregoing discussion and the patentability of the claims under consideration, applicants respectfully request reconsideration and allowance of the present application and rejoinder of dependent method claims 6-8 pursuant to the provisions of MPEP §821.04(b).

Should the Examiner wish to discuss any aspect of the present application, the Examiner is invited to contact the undersigned attorney at the telephone number provided below.

Respectfully submitted,

Buchanan Ingersoll & Rooney pc

By: 

Robert G. Mukai  
Registration No. 28531

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620

Date: December 31, 2008